

REMARKS

In the Final Office Action¹, the Examiner:

rejected claims 1-6, 9-11, and 13-19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,579,472 to Keyworth, II et al ("Keyworth") in view of U.S. Patent 6,466,654 to Cooper et al. ("Cooper"), further in view of U.S. Patent Application Publication 2004/0155908 to Wagner ("Wagner").

By this amendment, Applicant amends claims 1, 4-6, 9, 11, 13, 16, 17, 19, cancel claims 2, 3, 10, and 18 without prejudice or disclaimer, and add new claims 20 and 21. Applicant has been careful not to add new matter; support for the amendments and new claims can be found at, for example, p. 4, ll. 10-20, p. 5, ll. 4-11, p. 5, ll. 18-29, and at least Figure 8 of Applicant's specification. Claims 1, 4-6, 9, 11, 13-17, and 19-21 are thus pending.

I. The Personal Interview of March 25, 2010

As an initial matter, Applicant thanks Examiner Heffington and Primary Examiner England for the time and courtesies extended to Applicant's representatives during the personal interview held March 25, 2010. During the interview, the prior art of record was discussed, along with a general overview of Applicant's invention. Furthermore, proposed amendments to the claims were discussed. Examiner Heffington indicated his intent to reconsider all rejections in light of the claim amendments proposed during

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

the interview. The remarks presented to and considered by the Examiners are summarized below.

II. **The rejection of claims 1-6, 9-11, and 13-19 under 35 U.S.C. §103(a) as being unpatentable over Keyworth in view of Cooper and Wagner**

Applicant respectfully traverses the rejection of claims 1-6, 9-11, and 13-19 under 35 U.S.C. § 103(a) as unpatentable over Keyworth in view of Cooper and Wagner.

A *prima facie* case of obviousness has not been established with respect to the claims.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. §2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II) (emphases added). “Office personnel must explain why

the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, as amended, recites:

selectively displaying on the visual display a message listing enabling review of summaries of unread electronic messages received without opening the unread electronic messages; and

altering the first indicator to provide, at the location on the home screen, a visually distinguishable non-numerical annunciation that new unread electronic messages have been received following display of the message listing.

(emphases added). Keyworth, Cooper, and Wagner, taken alone or in combination, fail to teach or suggest at least the steps of selectively displaying and altering recited in amended independent claim 1.

Keyworth is directed to a system and method “having a communications user interface that displays queue and message information particular not only to a specific communications medium, but that actually segregates and displays the information for individual members within a select group.” Keyworth, col. 1, ll. 46-51. “Messages sent by, or received by, the subscriber are stored in data storage device 22 and are monitored by processor 21. Status indicator boxes 50e are updated from time to time, as appropriate, by processor 21 to alert the subscriber concerning the current status of messages of the type represented by that directional icon.” Keyworth, col. 4, ll. 36-41. “[T]he display for indicator boxes 50e employs color coding to alert the subscriber, at a glance, of the current status of incoming and outgoing messages. Thus, for example, the number of new incoming messages from a given member of the VIP gallery may be displayed before the word ‘NEW’ in a box having a pink background under the incoming

directional icon, while the number of old messages from that person might appear before the word 'OLD' in a box having a light blue background." Keyworth, col. 4, ll. 43-51. "Each message is assigned its own line of information fields which include whether the message has previously been read or heard by the subscriber (i.e. OLD) or just received (i.e., NEW)." Keyworth, col. 7, ll. 6-9. "Beneath queue 94 appears information window 95 which displays the text of a message, or the path name of a voice mail file, if that file is selected using pointing device 24 of computer 20." Keyworth, col. 7, ll. 21-24.

While Keyworth may disclose indicators of NEW and OLD, and may provide an information window displaying the text of a message, Keyworth does not teach providing any sort of visually distinguishable non-numerical annunciation reflecting that "new unread electronic messages have been received following display of the message listing," as recited in amended independent claim 1. Rather, the status identifiers of Keyworth are based only on the statuses of the messages themselves, and the presence of, or lack of, any visually distinguishable non-numerical annunciation is not based on the user's accessing of the information window to view the listing of messages. Furthermore, Keyworth does not provide any sort of screen "enabling review of summaries of unread electronic messages received without opening the unread electronic messages," as recited in amended independent claim 1.

Accordingly, Keyworth does not teach or suggest "selectively displaying on the visual display a message listing enabling review of summaries of unread electronic messages received without opening the unread electronic messages [and] provid[ing], at the location on the home screen, a visually distinguishable non-numerical

annunciation that new unread electronic messages have been received following display of the message listing,” as recited in amended independent claim 1.

The Office Action concedes that Keyword “does not disclose altering said first indicator to provide a second indicator at the location on the visual display that provides a visually distinguishable annunciation by altering said first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned.” Final Office Action at 8. The Office Action relies on Cooper to cure the deficiencies of Keyword. However, Cooper does not compensate for the deficiencies of Keyword.

Cooper discloses a “computer application with a voice user interface, such as a virtual assistance, that allows a user to semantically tag a set of objects so that the user can easily navigate and selectively receive objects from the set.” Cooper, col. 1, ll. 12-16. “The object type is a voicemail message, email message, meeting request, task request or fax. The taggable field for the voicemail message type is caller’s name, callback number, delivery date, subject or status.” Cooper, col. 3, ll. 8-11. “The taggable field value for the status field is first, last new, old, read, unread, deleted or urgent.” Cooper, col. 3, ll. 20-22. “The VA provides several different options for listening to messages. These options allow a user to quickly determine which messages are important and then obtain more detail about them.” Cooper, col. 50, ll. 17-20. “If a user instructs the VA to ‘Read my messages,’ the VA reads all messages in order, beginning with the oldest new message. However, there are many options that allow a user to specify which message or messages VA should read. ‘New’ messages are those that have been received since the user last called the VA (and, perhaps, since the

user last checked messages on a personal computer). ‘Old’ messages include all other messages, even if they have not been read.” Cooper, col. 50, ll. 36-44. “‘Read’ messages are those that the VA has read to the user or the user has read with Outlook on a personal computer. ‘Unread’ messages are those that the VA has not read to the user and the user has not read with Outlook.” Cooper, col. 50, ll. 51-54.

Thus, in Cooper, “New” messages are messages that have been received since the user last either called the virtual assistance, or checked messages on a computer, while “Old” messages include all messages that are not “New,” even if they have not been read. See Cooper, col. 50, ll. 41-44. While Cooper may discuss a category for messages received since the user last checked messages, Cooper does not provide any discussion of any visual representation regarding the “New” or “Old” statuses of the message, and does not discuss a visually distinguishable non-numerical annunciation reflecting a message status.

Furthermore, there is no discussion in Cooper of what causes messages to be assigned the “Old” designation, other than the vague discussion of “check[ing] messages on a personal computer.” Cooper, col. 50, line 43. There is no discussion in Cooper of providing the annunciation following display of “a message listing enabling review of summaries of unread electronic messages received without requiring opening of the unread electronic messages,” as recited in independent claim 1.

For at least these reasons, Keyworth and Cooper do not teach or suggest “selectively displaying on the visual display a message listing enabling review of summaries of unread electronic messages received without opening the unread electronic messages [and] provid[ing], at the location on the home screen, a visually

distinguishable non-numerical annunciation that new unread electronic messages have been received following display of the message listing,” as recited in amended independent claim 1 (emphases added).

Furthermore, Wagner does not compensate for the deficiencies of Keyworth and Cooper. Wagner discloses a user interface for a mobile device, where “icons are displayed in various locations on the context-based display 300 dependent on predicted usage.” Wagner, ¶ [0056]. “In additional to using positional data to assist the user in service and application selection, the service management system also provides information icon labels 310. Each informational icon label 310 presents specific information regarding the state of that particular service of application as it applies to the user.” Wagner, ¶ [0059]. “[A] mail icon may display a counter that changes to indicate the number of unread messages a user has.” Wagner, ¶ [0060].

While Figure 3 of Wagner may show a message icon having two informational icon labels, there is no discussion regarding how or when these informational icon labels are displayed. Wagner provides no detailed discussion regarding the displayed counters, and does not define when a message is considered read or unread. Accordingly, combinations Keyworth, Cooper, and Wagner do not teach or suggest “selectively displaying on the visual display a message listing enabling review of summaries of unread electronic messages received without opening the unread electronic messages [and] provid[ing], at the location on the home screen, a visually distinguishable non-numerical annunciation that new unread electronic messages have been received following display of the message listing,” as recited in amended independent claim 1 (emphases added).

For at least the above reasons, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 1. Accordingly, the Final Office Action has not clearly articulated a reason as to why the claim would have been obvious to one of ordinary skill in view of the prior art. A prima facie case of obviousness has not been established for independent claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 4, 11, and 19, while of different scope from claim 1, are also allowable over Keyworth, Cooper, and Wagner for at least similar reasons as those set forth in connection with independent claim 1.

Claims 5, 6, 9, and 13-17 depend from independent claims 4 and 11, and because Keyworth, Cooper, and Wagner do not support the rejection of independent claims 4 and 11, under 35 U.S.C. § 103(a), Keyworth, Cooper, and Wagner also do not support the rejection of the dependent claims.

III. Newly added claims 20 and 21

For at least the above reasons, Keyworth, Cooper, and Wagner, taken individually or in combination, also fail to teach or suggest all the recitations of newly added claims 20 and 21. Additionally, newly added independent claim 20 recites “updating the associated value to provide a single value simultaneously reflecting the number of unread electronic messages and the number of new unread electronic message received following display of the message listing.” Keyworth, Cooper, and Wagner fail to teach or suggest at least this element of independent claim 20.

Newly added dependent claims 21 depends from independent claim 20, and is allowable at least in view of its dependence. Accordingly, Applicant respectfully requests the timely allowance of claims 20 and 21.

IV. **The Office Action has relied on improper hindsight in combining Keyworth, Cooper, and Wagner**

As set forth above, combinations of Keyworth, Cooper, and Wagner do not teach or suggest each and every element of the claims. Moreover, even assuming, for the sake of argument, that combinations of the cited art did in fact teach each and every element of the claims, which Applicant refutes, the Office Action's proposed combination of Keyworth, Cooper, and Wagner is improper as it relies on impermissible hindsight in arriving at the claimed invention, as one of ordinary skill in the art would not look to combine Keyworth and Cooper based on their different definitions of message statuses.

As set forth above, Keyworth only makes a distinction between "NEW" messages and "OLD" messages, where a message is "NEW" until it is "read or heard by the subscriber" Keyworth, col. 7, line 8. Thus, in Keyworth, a user could access the message queue, such as shown in Figure 6 of Keyworth, and decide not to check a particular message. If the user then accesses the VIP gallery, such as shown in Figure 3 of Keyworth, the indicators of what constitutes a new or old message will not change. Rather, the new status of any message will persist until the user reads or hears a message.

In contrast, Cooper provides a distinction between "New" and "Old" messages, where "New" messages are only those messages that have been received since the

user last called the VA, or checked the messages on a personal computer.

See Cooper, col. 50, ll. 41-43. Otherwise, even if a user has not read a particular message, the message could be still be designated as “Old.” See Cooper, col. 50, ll. 43-44. Thus, Cooper provides a completely different definition of what a “New” and “Old” message is as compared to the definitions set forth in Keyword. Accordingly, one of ordinary skill in the art would not look to redefine the established message statuses provided in Keyword, as Keyword deliberately defined their uses of “New” and “Old” status identifiers, and there is no indication that Keyword intended for messages to be indicated as “Old” when they have not in fact been “read or heard by the subscriber.” Keyword, col. 7, line 8. Such a modification proposed by the Office Action would go against the disclosure of Keyword.

Furthermore, the Office Action’s allegation that “it is within the scope of Keyword to indicate a message received since the user last checked, or scanned the messages” (Final Office Action at 7), is entirely unsupported by the disclosure of Keyword. Keyword discloses that the incoming message queue displays, for each message in the queue, information fields, where one of the information fields is “when the message was received.” Keyword, col. 8, lines 49-58. As can be seen in Figure 11 of Keyword, this is simply used to indicate a time of receipt, shown in the “Received” column. There is simply no discussion in Keyword to support the allegation that Keyword intends to use this time of receipt information “to indicate a message received since the user last checked, or scanned the messages,” as alleged by the Office Action. Final Office Action at 7. Such an allegation is completely unsupported by the disclosure of Keyword, and as set forth above, Keyword explicitly defined when a message is “New”

or "Old," and therefore would not be concerned with a message having been received since the user last checked the messages.

Accordingly, one of ordinary skill in the art would not look to combine Keyworth and Cooper in the manner suggested by the Office Action, and the proposed combination of Keyworth, Cooper, and Wagner is nothing more than impermissible hindsight reconstruction using Applicant's disclosure. Applicant respectfully requests the timely allowance of the claims for at least this independent reason.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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